

PATENT
App. Dkt. No. CRU00020(Y1)**REMARKS**

This is intended as a full and complete response to the Final Office Action dated February 8, 2006, having a shortened statutory period for response set to expire on May 8, 2006. Claims 1, 4-12, 15-29, 32, 37, 38, 47, 48, 65-70 and 77-80 are pending in the application. Please reconsider the claims pending in the application for reasons discussed below.

Election/Restrictions

In the Office Action, the Examiner has withdrawn newly submitted claims 71-76 from consideration as being directed to a non-elected invention. According to the Examiner, claims 71-76 are directed to an invention that is independent or distinct from the invention originally claimed since the expansion can occur in two different directions.

Applicants respectfully traverse the restriction of claims 71-76. Contrary to the assertion by the Examiner, new submitted claims 71-76 are directed to the elected invention in the Species of Figures 3-5 and Figs. 6-8. Because claims 71-76 recites limitations directed to the elected invention, they are properly pending in this application and should be prosecuted with the other pending claims. Applicants respectfully request withdrawal of the restriction requirement of claims 71-76. Furthermore, Applicants believe that new claims 71-76 are in condition for allowance and respectfully request the same.

Claim Rejections Under 35 U.S.C. § 103(a)

The Examiner rejected claims 1, 38, 47, and 65 as being obvious over *Evans* (US. 6,409,175) in view of *Blose* (US. 4,822,081). In the office action, the Examiner states that *Evans* discloses all the limitations of the above referenced claims except for dovetail threads with flank angles greater than 10 degrees. As such, the Examiner attempts to supplement this missing limitation with *Blose*. According to the Examiner, it would have obvious to one having ordinary skill in the art at the time the invention was made to configure the threads of *Evans* to be threads that are dovetail threads with

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inclined flanks as taught by *Blose* to provide axial compressive loads and prevent separation of the joint.

Applicants respectfully traverse the rejection on grounds that the Examiner has failed to establish a *prima facie* case of obviousness. To establish *prima facie* case of obviousness, all claim limitations must be taught or suggested by the prior art. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Claim 1 includes the limitation of an undercut groove along the end portion of the second tubular adapted to receive the nose of the first tubular and to prevent the nose from separating as the first tubular elongates axially and the second tubular contracts axially while the coupling is diametrically expanded. Claim 38 includes the limitation of a second tubular having a sealing member capable of swelling upon contact with a selected material. Claim 47 includes the limitation of a groove and a nose configured to have a pre-expanded relative position and a post expanded relative position, whereby in the pre-expanded relative position the nose is spaced apart from the groove at a first axial distance and in the post expanded relative position the nose is spaced apart from the groove at a smaller second axial distance. Claim 65 includes the limitation of a box member having a plurality of dovetail threads and a recess, the recess and the end portion having a first relative position prior to expansion of the connection and a second relative position following expansion of the connection, whereby in the first position the end portion is spaced apart from the recess at a first axial distance and in the second position the end portion is spaced apart from the recess at a smaller second axial distance. Contrary to the assertion by the Examiner, the combination of *Evans* and *Blose* does not disclose these limitations. Rather, *Evans* merely shows a seal assembly that includes an annular groove, whereby the groove width is reduced upon expansion of the seal assembly. (See *Evans*, col. 9, lines 34-39). Further, as admitted by the Examiner in section 4 of the office action, *Evans* fails to disclose an elastomer that is capable of swelling when applied with fluid. Moreover, *Evans* clearly shows a seal assembly having a nose portion abutted against a groove portion in both a first relative position prior to expansion of the connection and a second relative position following expansion of the seal assembly. (See *Evans*, Figures 7A and 7B) Additionally, *Blose* fails to cure the deficiencies of *Evans*.

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In addition, to establish *prima facie* case of obviousness, the teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not in the applicants' disclosure. See M.P.E.P. § 2143, citing *In re Vaack*, 947 F.2d 488 (Fed. Cir. 1991). Still further, the examiner must *particularly* identify any suggestion, teaching or motivation from *within* the references to combine the references (emphasis added). See *In Re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). The mere recitation of a combination of references does not amount to particularly identifying a suggestion, teaching, or a motivation to combine the references. Finally, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

As set forth above, the Examiner failed to establish *prima facie* case of obviousness. As a result, the combination of *Evans* and *Blose* fails to render claims 1, 38, 47 and 65 obvious. Applicants therefore submit that claims 1, 38, 47, and 65 are in condition for allowance and respectfully request withdrawal of the § 103(a) rejection. Additionally, claims 4-12, 15-26, and 32 depend from claim 1, claims 66-68 and 70 depend from claim 65 and claims 79-80 depend from claim 37 and they are allowable for at least the same reasons as claims 1, 37, and 65.

The Examiner rejected 37 and 48 as being obvious over *Evans*, *Blose*, and *Kramer* (US. 3,915,460). In the office action, the Examiner states that *Evans* and *Blose* discloses all the limitations of the above referenced claims except for an elastomer that is capable of swelling when applied with fluid. As such, the Examiner attempts to supplement this missing limitation with *Kramer*. According to the Examiner, it would have obvious to one having ordinary skill in the art at the time the invention was made to configure the elastomer of *Evans* to be a swellable elastomer as taught by *Kramer* to provide a sealing element that absorbs fluid that leaks past a joint.

Applicants respectfully traverse the rejection on grounds that the Examiner has failed to establish a *prima facie* case of obviousness. To establish *prima facie* case of obviousness, all claim limitations must be taught or suggested by the prior art. See *In*

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re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Claims 37 and 48 include the limitation of a first seal member capable of swelling upon contact with a selected material and a second seal member capable of swelling upon contact with a different selected material. Contrary to the assertion by the Examiner, the combination of *Evans* and *Blose* and *Kramer* does not disclose this limitation. Rather, *Kramer* merely discloses a seal member capable of swelling upon absorption of a single selected material (hydrocarbons). (See *Kramer*, col. 4, lines 34-64) In fact, there is no mention in *Kramer* about a second seal member capable of swelling upon contact with a different selected material which is distinct from the selected material (hydrocarbons). Additionally, *Evans* and *Blose* fail to cure the deficiencies of *Kramer*.

In addition, to establish *prima facie* case of obviousness of the claimed invention, the teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not in the applicants' disclosure. See M.P.E.P. § 2143, citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Still further, the examiner must *particularly* identify any suggestion, teaching or motivation from *within* the references to combine the references (emphasis added). See *In Re Demblczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). The mere recitation of a combination of references does not amount to particularly identifying a suggestion, teaching, or a motivation to combine the references. Finally, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

As set forth above, the Examiner failed to establish *prima facie* case of obviousness. As a result, the combination of *Evans* and *Blose* and *Kramer* fails to render claims 37 and 48 obvious. Applicants therefore submit that claims 37 and 48 are in condition for allowance and respectfully request withdrawal of the § 103(a) rejection. Additionally, claims 18, and 27-29 depend from claim 1 and claims 77-78 depend from claim 37 and they are allowable for at least the same reasons as claims 1 and 37.

Furthermore, the Examiner stated in section 5 of the Office Action that *Voitik* (US. 3,945,650) produces evidence that elastomers are known to swell when exposed to fluid.

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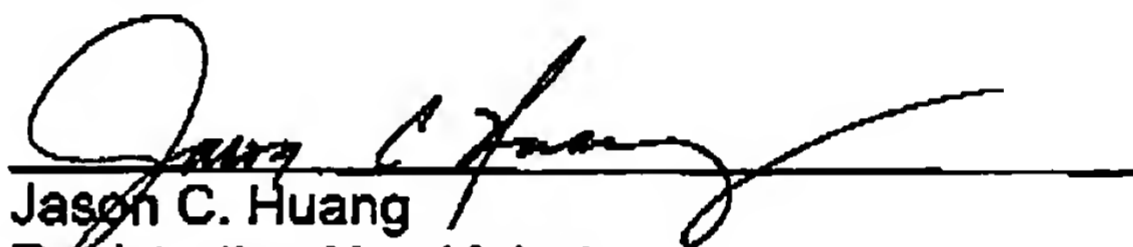
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Applicants note that *Voitik* was not used by the Examiner to reject any of the pending claims. However, even if *Voitik* was used by the Examiner, *Voitik* clearly does not disclose a first seal member capable of swelling upon contact with a selected material and a second seal member capable of swelling upon contact with a different selected material.

Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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